

tesa 642-HCL  
3162-St-stl**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

**REMARKS*****Summary of Claim Amendments***

Claim 1 has been amended to define the role of the reactive phenolic resin (see e.g. page 1, lines 12-13 for support) and indicate that the accelerator substances are optional (see examples P1-P3, P5, P7 and P8)

Claims 13-15 are narrower embodiments of claim 1 which are intended to encompass examples P1-P8 in the specification. Support for claims 16-18 can be found for example on page 6, lines 26-29.

***35 U.S.C. 112, second paragraph rejection***

Claim 1 has been amended to more clearly define that the reactive phenolic resin is a crosslinker within the context of the applicants' claimed invention.

***35 U.S.C. 103(a) rejection***

Claims 1-12 were rejected by the examiner as being obvious over any one of Berejka (U.S. Patent 4,332,655); Chiu (U.S. Patent 5,095,068); Medsker et al. (U.S. Patent 5,952,425); or Kelley et al. (U.S. Patent 6,287,411).

The examiner stated that each of the cited references disclosed phenolic resins having methylol groups and disclosed elastomers and tackifying resins. The examiner also further writes:

"It would have been obvious to one of ordinary skill in the art to formulate adhesive

tesa 642-HCL  
3162-St-sti

compositions comprising elastomer, tackifying resin, and the required phenolic resin having methylol groups.

The motivation is that elastomers and tackifying resins are conventional ingredients in adhesive compositions and it would be within the skill of one in the art to formulate adhesive compositions comprising elastomer, tackifying resin, and the required phenolic resin within the context of Berejka or Chiu or Medsker or Kelley."

While the applicants believe that none of the four references cited render the applicants' claimed invention obvious, it appears the four references differ in the scope of their teachings and as such differ in their relevance with respect to the claimed invention. The references are discussed below in order of relevance (highest to lowest).

- (1) The Chiu reference discloses certain elements of the applicants' invention, but when making an "as a whole" analysis of the reference and the applicants' claimed invention (see MPEP 2141.02), it becomes apparent that the Chiu reference does not render the applicants' invention as amended to be obvious.

The applicants' claimed invention includes several numerical limitations which have not been addressed by the examiner and as such does meet the "as a whole" analysis requirement under 103(a). Moreover, the Chiu reference requires additional elements which are not required elements of the applicants claimed invention.

Chiu discloses adhesives which are comprised of butyl rubber, curing agent, carbon black and tackifier. It can be seen from reading the specification that zinc oxide and sulfur are critical components of their invention (see e.g. col. 3, lines 54-56; col. 7, lines 37-47 and Examples A-F in Table I). Carbon black, zinc oxide and sulfur are not essential elements of the applicants' claimed invention.

Chiu discloses that phenolic resins may be used as curing agents, but does not teach the numerical limitation of being 1 to 100 parts by mass or that the methylol content is from 1 to 20% based on the reactive phenolic resin.

Likewise, Chiu generically discloses non-thermoplastic elastomers (specifically butylated

tesa 642-HCL  
3162-St-sti

rubber) and tackifiers but does not teach the respective "at least 100 parts" and "1 to 100 parts" limitations in combination as claimed by the applicants. The guidance provided by Chiu would direct one of ordinary skill in the art away from the applicants invention. Claim 1 teaches a "minor portion of a butyl rubber copolymer" and a "major portion of a tackifier". Moreover, when reviewing the examples of Table I in Chiu, it can be seen that there is indeed a "major" amount of tackifier (i.e. the components labeled "Piccotac" and "H-300") and that this "major" amount falls within the range claimed by the applicants.

However, the amount of non-thermoplastic elastomer described in Table I is well below the "at least 100 parts by mass" limitation of the applicants claimed invention. The applicants claim 1 as amended would not be readable upon the "major"/"minor" distinctions made in the Chiu reference.

In the event that one would assume that 35 parts of butylated rubber would be suggestive of greater than 100 parts or suggest a reversal of the "major"/"minor" relationship in Chiu's invention, it is noted that Chiu also discloses several highly specific physical characteristics with their invention (e.g. tensile strength of at least 50 psi, an elongation of at least 600%, a modulus of 300% elongation of not more than 12 psi, a modulus of failure of not more than 20 psi, etc.). As such, it cannot be presumed that a modification of the Chiu reference will not change the principle of operation of their invention (see MPEP 2143.01 – 2100-125).

To arrive at the applicants' invention with Chiu would require picking and choosing of appropriate elements and hoping that the modifications did not change the essence of Chiu's invention. However, it has previously been held that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

More recently, it has been held that "...Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

tesa 642-HCL  
3162-St-std

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person or ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.") see *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

- (2) There are several differences between the Berejka reference and the applicants' invention which include:
- (a) The Berejka reference does not teach the inclusion of phenolic resins as part of their adhesive composition.
  - (b) The Berejka reference does not teach the specific amount of components used in the applicants claimed invention.
  - (c) With the amendment of the claimed invention, the Berejka reference does not teach the tackifying resins used in the applicants' claimed invention.

The teachings of Berejka do not remedy these differences and as such the applicants' claimed invention would not be deemed to be obvious by one of ordinary skill in the art.

- (3) There are several differences between the Medsker et al. reference and the applicants' invention which include:
- (a) The applicants' claimed invention is based on non-thermoplastic elastomers whereas the Medsker et al. reference relates to thermoplastic vulcanizates.

tesa 842-HCL  
3162-St-stl

- (b) The applicants' claimed invention is a hot-melt pressure-sensitive adhesive whereas the Medsker et al. reference is directed toward forming rubbery articles.
- (c) Medsker et al. does use or suggest the use of a tackifying resin (even if it were to be accepted that phenolic resins could be a tackifying resin, this is not how the phenolic resins are being used in Medsker et al.). Moreover, with the applicants amendments, Medsker et al. does not teach or suggest the list of tackifying resins currently claimed.
- (d) There is no teaching in Kelley et al. for the specific amount of the components used in the applicants claimed invention.

The teachings of Medsker et al. do not remedy these differences and as such the applicants' claimed invention would not be deemed to be obvious by one of ordinary skill in the art.

- (4) There are several differences between the Kelley et al. reference and the applicants' invention which include:
  - (a) The applicants' claimed invention is based on non-thermoplastic elastomers whereas the Kelley et al. reference relates to thermoplastic elastomers.
  - (b) The applicants' claimed invention is a hot-melt pressure-sensitive adhesive whereas the Kelley et al. reference is directed toward bonding a thermoplastic elastomer with a magnesium containing metal using an adhesive (i.e. the elastomer is not part of the adhesive and the adhesives used by Kelley et al. are not novel elements of their invention, i.e. they use conventional adhesive known in the art – see col. 9-10 of Kelley et al.).
  - (c) There is no teaching in Kelley et al. of an adhesive comprised of a non-thermoplastic elastomer, one or more tackifying agents and a phenolic

tesa 642-HCL  
3162-St-sti

resin.

- (d) There is no teaching in Kelley et al. for the specific amount of the components used in the applicants claimed invention.

The teachings of Kelley et al. do not remedy these differences and as such the applicants' claimed invention would not be deemed to be obvious by one of ordinary skill in the art.

With regard to the statement of motivation for modifying the cited references to arrive at the applicants' claimed invention, the examiner is reminded that "within the capabilities of one of ordinary skill in the art is not sufficient to establish *prima facie* obviousness" (see MPEP 2143.01 – page 2100-124): "A statement that modification of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). see also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)".

The applicants also submit that the newly added claims are not obvious when compared to the teachings of the references cited by the examiner.

### ***Closing***

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By: Howard C. Lee  
Howard C. Lee  
Reg. No. 48,104